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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/515,928

02/29/2000

Bert Whitmore Elliott

24673A

1357

7590  
OWENS CORNING  
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04/10/2007

EXAMINER

CANFIELD, ROBERT

ART UNIT

PAPER NUMBER

3635

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

09/515,928

**Applicant(s)**

ELLIOTT, BERT WHITMORE

**Examiner**

Robert J. Canfield

**Art Unit**

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17, 46-48, 52-58 and 62-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17, 46-48, 52-58 and 62-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. This Office action is in response to the amendment filed 01/11/07. Claims 17, 46-48, 52-58 and 62-73 are pending. Claims 1-16, 18-45, 49-51 and 59-61 have been canceled.

2. The amendment filed 07/27/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: U.S. application serial number 09/292,488, now USP 6,253,512, incorporated by reference does disclose a predominant color blend in roughly 60% of the tabs but fails disclose **the complete range of “over 50%”, or the specific percents of 55%, 56% or 58%.**

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 52-54, 62-64 and 69 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to describe or discuss the specific percentiles now claimed. This is a new matter rejection. U.S.

application serial number 09/292,488, now USP 6,253,512, incorporated by reference does disclose a predominant color blend in roughly 60% of the tabs but fails disclose **the complete range of “over 50%” (claims 52, 62 and 69).**

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 67-69 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,014,847 to Phillips in view of U.S. Patent 1,843,370 to Overbury.

Phillips provides laminated shingles having an overlay member 12 provided with generally rectangular tabs 20a-20c of different sizes, which are separated by cutouts 22a-22c. The figures show three tabs. The widths of the cutouts are considered sufficiently narrow to simulate slate tiles. Further, the reference states that the widths of the tabs may be varied depending on the desired appearance, which would suggest that the tabs could have been made wider which would result in narrower cutouts. The overlay 12 is laminated to an underlay 14 which is provided a layer of granules substantially darker than that those of the overlay. The lower edge of overlay member is shown generally co-linear with the lower edge of the underlay member.

Phillips fails to teach that the color blends of the tabs of the overlay members are different from another with one of the color blends occurring more frequently than any of the other color blends.

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Phillips also fails to specify gray as the predominant color blend.

Overbury teaches that at the time of the invention it was known to make the tabs of a shingle of different colors and to confine each color to the portion which corresponds to one tab (column 2, lines 20+) for aesthetic purposes. Overbury further provides that if desired two or more tabs may be given the same color (page 2, line 96). Figure 6 of Overbury shows multiple tabs of different colors with one of the tabs (left most) being predominant.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the tabs of the overlay of Phillips could have been provided with color blends different from one another with one color blend occurring more frequently, as taught by Overbury, to achieve a desired artistic effect. Phillips teaches at the top of column 4, that it should be understood that different color arrangements could be used. The choice of gray as the predominantly color blend is nothing other than a choice of design which would have been obvious at the time of the invention to one having ordinary skill in the art. Gray is a common shingle color. Further, Overbury suggests variety of colors and calls for crushed slate (generally recognized as gray in color) as the granular material and references the material as "slated sheet material" at line 82. The particular percentages recited in the claims would have been nothing other than obvious choices of design at the time of the invention to one having ordinary skill in the art as Overbury teaches great possibilities of variance for artistic effects. Further, applicant's specification fails to provide any problem in the art solved by the

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particular percentiles claimed and in fact never even mentions the percentiles now claimed.

7. Claims 17, 46-48 and 52-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,195, 290 to Hulett in view of U.S. Patent 1,843,370 to Overbury.

Hulett provides laminated shingles having overlay members provided with a plurality of generally rectangle tabs (figures 5, 6, and 8) separated by cutouts and underlay members provided with darker granules for a more pleasing appearance (column 4, lines 63+). The cutouts are shown narrow when compared to the tabs. The figures show embodiments including at least four tabs. The particular dimensions of about 1 inch for the width of the cutouts and about 6 inches for the width of the tabs is viewed as a choice of design which would have been obvious to one having ordinary skill at the time of the invention. The figures clearly show the cutouts as narrower than the tabs and the particular dimensions would have been nothing other than a design choice to achieve a desired appearance.

Hulett fails to teach that the color blends of the tabs of the overlay members are different from another with one of the color blends occurring more frequently than any of the other color blends.

Hulett also fails to specify gray as the predominant color blend.

Overbury teaches that at the time of the invention it was known to make the tabs of a shingle of different colors and to confine each color to the portion which corresponds to one tab (column 2, lines 20+) for aesthetic purposes. Overbury further provides that if desired two or more tabs may be given the same color (page 2, line 96). Figure 6 of Overbury shows multiple tabs of different colors with one of the tabs (left most) being predominant.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the tabs of the overlay of Hulett could have been provided with color blends different from one another with one color blend occurring more frequently, as taught by Overbury, to achieve a desired artistic effect.

The choice of gray as the predominantly color blend is nothing other than a choice of design which would have been obvious at the time of the invention to one having ordinary skill in the art. Gray is a common shingle color. Further, Overbury suggests variety of colors and calls for crushed slate (generally recognized as gray in color) as the granular material and references the material as "slated sheet material" at line 82. The particular percentages recited in the claims would have been nothing other than obvious choices of design at the time of the invention to one having ordinary skill in the art as Overbury teaches great possibilities of variance for artistic effects. Further, applicant's specification fails to provide any problem in the art solved by the particular percentiles claimed.

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8. Claims 17, 46-48 and 52-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,939,169 to Bondoc et al. in view of U.S. Patent 1,843,370 to Overbury.

Bondoc laminated shingles having overlay members provided with a plurality of generally rectangle tabs 16 and separated by narrow cutouts, which have beveled edges in the embodiment of Figures 4A-4C, and underlay members 11, 15 provided with darker granules. The cutouts are shown narrow when compared to the tabs. The figures show embodiments including at least four tabs. The particular dimensions of about 1 inch for the width of the cutouts and about 6 inches for the width of the tabs is viewed as a choice of design which would have been obvious to one having ordinary skill at the time of the invention. The figures clearly show the cutouts as narrower than the tabs and the particular dimensions would have been nothing other than a design choice to achieve a desired appearance.

Bondoc fails to teach that the color blends of the tabs of the overlay members are different from another with one of the color blends occurring more frequently than any of the other color blends.

Bondoc also fails to specify gray as the predominant color blend.

Overbury teaches that at the time of the invention it was known to make the tabs of a shingle of different colors and to confine each color to the portion which corresponds to one tab (column 2, lines 20+) for aesthetic purposes. Overbury further provides that if desired two or more tabs may be given the same color



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(page 2, line 96). Figure 6 of Overbury shows multiple tabs of different colors with one of the tabs (left most) being predominant.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the tabs of the overlay of Bondoc could have been provided with color blends different from one another with one color blend occurring more frequently, as taught by Overbury, to achieve a desired artistic effect.

The choice of gray as the predominantly color blend is nothing other than a choice of design which would have been obvious at the time of the invention to one having ordinary skill in the art. Gray is a common shingle color. Further, Overbury suggests variety of colors and calls for crushed slate (generally recognized as gray in color) as the granular material and references the material as "slated sheet material" at line 82. The particular percentages recited in the claims would have been nothing other than obvious choices of design at the time of the invention to one having ordinary skill in the art as Overbury teaches great possibilities of variance for artistic effects. Further, applicant's specification fails to provide any problem in the art solved by the particular percentiles claimed and in fact never even mentions the percentiles now claimed.

9. Applicant's arguments filed 01/11/07 have been fully considered but they are not persuasive.

Applicant argues that the specific percentages of predominant color blends are supports in U.S. application 09/292,488, now U.S. Patent 6,253,512 to

Thompson which is incorporated by reference. Applicant's own analysis fails to provide the claimed percentages. 55.6%, 56.4% and 58.3% are not 55%, 56% and 58%. Further, there is no support for the complete range of over 50% which has been added.

Applicant admits on page 10 of his remarks that Overbury teaches an alternate embodiment having more tabs of one color than of other colors but contends that the substance of this alternate embodiment does not result in a roof having an appearance of a natural slate roof. This is not found persuasive

Overbury suggests variety of possible colors including crushed slate (generally recognized as gray in color) as the granular material and references the material as "slated sheet material" at line 82. When using crushed slate as a predominant color the roof will inherently simulate a natural slate roof.

Applicant's argument that none of the references teach one of the color blends occurring more frequently or predominantly than the others is not found persuasive. Overbury clearly shows in at least Figure 6 one color blend occurring more predominantly than others. Also, Overbury recites at page 2 lines 94-96 that if desired two or more tabs may be given the same color.

Applicant's argument that none of the references teaches gray as the predominant color so as to simulate a natural slate roof is not found persuasive. Overbury teaches that any or a variety of colors may be chosen and even discusses crushed slate as the granular material used on the tabs. Each of which would have suggested the use of the color gray to one having ordinary skill in the

art at the time of the invention. To have made gray the predominant color would have been obvious if one is attempting to simulate slate as Overbury is.

Applicant's argument that Overbury only teaches a predominant color as an occasional variation of the primary embodiment is not found persuasive.

Overbury does provide the teaching and the fact that it may or may not be the preferred embodiment has no bearing on the fact that it is taught.

10. The declaration under 37 CFR 1.132 filed 07/27/06 is insufficient to overcome the rejection of claims as set forth in the last Office action because:

An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. The PTO must rely upon the applicant to provide hard evidence of commercial success. Objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. The declaration claims commercial success of and long felt need for the Bershire ® shingles but fails to provide the required nexus between the claimed invention and the alleged commercial success. There is no evidence that any alleged commercial success is derived from the claimed invention in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous

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to the merits of the claimed invention, etc. Applicant has failed to show that the claimed features are responsible for any alleged commercial success.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

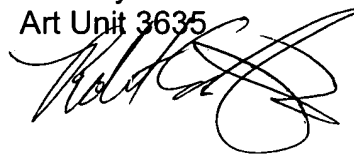
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Canfield whose telephone number is 571-272-6840. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert J Canfield  
Primary Examiner  
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A handwritten signature in black ink, appearing to read 'Robert J Canfield', is written over the printed name and title.